

is a user request to store or reproduce data, the controller 13 “checks whether the disc is rotating at a speed suitable for the storing and reproducing of the user’s request.” *Id.* The recording speed is an example of a rotation mode. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 U.S.PQ.2d 1057 (Fed. Cir. 1993). Applicant respectfully requests that the rejection of these claims be withdrawn.

Claims 1, 8, 9, and 16-18 stand rejected under 35 U.S.C. §102(b) as being anticipated by Hashimoto (US 6,172,955). This rejection is respectfully traversed.

Claims 1, 9, and 18 recite “background-formatting the recording medium in a first rotation mode suitable for the background-formatting, ... receiving a user request for writing user data ..., [and] determining whether the first rotation mode is suitable for writing the user data in response to receipt of the user request.” (Emphasis added.) Claims 1, 9, and 18 further recite “if the first rotation mode is suitable ..., writing the user data ..., [but] if the first rotation mode is not suitable ..., rotating the recording medium in a second rotation mode and writing the user data.” (Emphasis added.)

Hashimoto discloses “if it is determined, in step S13, that a request for recording is sent ... [i]n step S14, the formatting operation is temporarily stopped so as to record a user data packet. After the recording of the user data packet ..., the routine proceeds.” Col 8, ln. 42-49; emphasis added. Hashimoto does not disclose the step of “determining whether the first rotation mode is suitable for writing the user data,” as recited in claims 1, 9, and 18. Nor is such a limitation inherent, as Hashimoto further discloses “it takes about 40 minutes to complete a recording of data including the TOC even if the recording is performed at a double recording speed.” Col. 2, ln. 35-37; emphasis added. There is no mention of using multiple rotation speeds or modes. Since Hashimoto does not disclose all the recited limitations, claims 1, 9, and 18 are not anticipated by

Hashimoto. Claim 8 depends from claim 1 and is patentable at least for the reasons mentioned above. Claims 16-17 depend from claim 9 and are patentable at least for the reasons mentioned above.

We understand the Examiner took the position that changing the speed is inherent to recording. However, the quoted material does not appear in the Hashimoto reference, either in the indicated location, or anywhere else. Further, as stated above, the only reference to any speed is "recording is performed at a double recording speed." Col. 2, ln. 35-37; emphasis added. There is no inherent change in speed. Therefore, Applicant respectfully requests that the 35 U.S.C. § 102(b) rejection of claims 1, 8, 9, and 16-18 be withdrawn.

Claims 2 and 10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto (US 6,172,955) in view of Horie (JP 2000-011380). This rejection is respectfully traversed. Claims 2 and 10 depend respectively on claims 1 and 9 and are patentable at least for the reasons mentioned above. Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claims 2 and 10 be withdrawn.

Claims 3-4 and 11-12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto (US 6,172,955) in view of Shirane (JP 07-262692). This rejection is respectfully traversed. Claims 3-4 depend on claim 1 and are patentable at least for the reasons mentioned above. Claims 11-12 depend on claim 9 and are patentable at least for the reasons mentioned above. Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claims 3-4 and 11-12 be withdrawn.

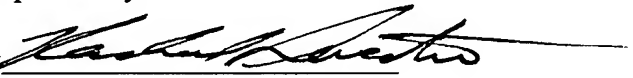
Claims 5-7 and 13-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto (US 6,172,955) in view of Seamons et al. (US 4,954,327). This rejection is respectfully traversed. Claims 5-7 depend on claim 1 and are patentable at least for

the reasons mentioned above. Claims 13-15 depend on claim 9 and are patentable at least for the reasons mentioned above. Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claims 5-7 and 13-15 be withdrawn.

In view of the above, Applicant believes the pending application is in condition for allowance.

Dated: September 12, 2005

Respectfully submitted,

By 

Mark J. Thronson

Registration No.: 33,082

Rachael Lea Leventhal

Registration No.: 54,266

DICKSTEIN SHAPIRO MORIN &  
OSHINSKY LLP

2101 L Street NW

Washington, DC 20037-1526

(202) 785-9700

Attorneys for Applicant